

Remarks

The Examiner has required restriction under 35 U.S.C. §121 between claims 1-27 (Invention I) and claims 28-45 (Invention II).

Applicants elect group I (claims 1-27) with traverse.

Applicants respectfully request reconsideration and withdrawal of the restriction requirement. In particular, Applicants respectfully submit that the restriction requirement is improper in view of the two previous examinations and issued office actions rejecting the claims on the merits.

Applicants refer to MPEP 803 (8th ed., rev. 6) where it is stated that *if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions*.

Applicants note that the Office has already fully examined this application on the merits as indicated by the November 2006 Office Action as well as the May 2007 Final Office Action. Indeed, the Office, in both Actions, issued prior art rejections of all pending claims. Accordingly, the Examiner has already searched and examined all pending claims of the application. In view of the prior search and substantive examination of the present application on two prior occasions, Applicant respectfully submits no serious burden of search and examination exists and Applicant respectfully requests withdrawal of the restriction requirement.

Now requiring elimination of any set of claims after the previous search and examination will not reduce the scope of searching, and thus there are no efficiencies gained by imposing a restriction requirement. In addition, restriction at this late time is not timely, and does not have any sense of fairness to Applicant. Applicants respectfully submit that there is no serious burden if restriction is not required in consideration of the previous search, examination and prosecution of each of the groups of the claims on the merits. Applicants respectfully submit that the restriction requirement is improper under MPEP 803 for at least these compelling reasons.

Applicant further refers to MPEP 808.02 (8th ed., rev. 6) entitled Establishing Burden. It is stated in such MPEP section that even if restriction is proper under MPEP §806.05 - 806.06 (the sections relied upon in formulating the restriction requirement), *the Examiner, in order to establish reasons for insisting*

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upon restriction, must explain why there would be a serious burden if restriction is not required. The Examiner must show by appropriate explanation one of the following: (a) separate classification, (b) separate status in the art when they are classifiable together, or (c) a different field of search. It is further stated in MPEP 808.02 that where the classification is the same and field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist dividing among related inventions.

The restriction requirement is entirely void of identifying any indication of separate future classification or field of search. Section B of MPEP 808.02 states that separate status in the art may be shown by citing patents which are evidence of such separate status, and also separate field of search. *No patents have been cited or other evidence offered to indicate the alleged separate status. In addition, no separate field of search is required inasmuch as the claims of the application have already been examined on the merits.* There is no indication that a different classification is provided or a different field of search is required. No clear indication of separate future classification and field of search are provided. As mandated by MPEP 808.02, no reasons exist for dividing among related inventions.

Applicants submit that there is no burden, let alone serious burden, in consideration of the previous search and examination of the pending claims now alleged to be in different groups. Furthermore, each of the independent claims have been rejected over the prior art resulting from the searching. There is no burden, let alone serious burden, in consideration of the prior search, examination and rejection of all of the pending independent claims over the prior art under section 102.

In addition, Applicants respectfully submit that the claims of the different groups recite the same or similar limitations, and accordingly, should be similarly classified. Applicants respectfully submit that the claims should be commonly classified as evidenced by the Office previously searching and examining all pending independent claims on the merits. There is insufficient burden pursuant to MPEP 808.02 in consideration of the previous search, examination and rejection of all claims, and Applicants respectfully request withdrawal of the restriction requirement for the above-mentioned compelling reasons.

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Furthermore, restriction is not proper since there is increased burden on the U.S. Patent and Trademark Office, on the Applicant and ultimately on the public in prosecuting multiple separate patent applications. For Applicant, splitting the invention into multiple cases increases costs associated with government fees, prosecution fees, and maintenance fees for multiple patents. For the PTO, there are increased costs associated with conducting multiple searches in multiple applications and multiple examinations for an invention that already has been searched and examined. It further ultimately produces a burden on the pertinent public that will review Applicant's commonly patented technology. Such people will be compelled to unnecessarily review multiple issued patents and file histories.

Applicants also note that the Office relies upon MPEP 806.05(c) (8th ed., rev. 6) in support of the restriction of inventions and which requires the Office to show that the combination *does not* require the particulars of the subcombination for patentability (to show novelty and unobviousness) and the subcombination can be shown to have utility either by itself or in other and different combinations. The restriction requirement is void any explanation to support restriction apart from the cursory unsupported statements in the restriction requirement that groups I and II are allegedly related as combination and subcombination. Applicants respectfully submit that restriction is improper for at least this reason.

Applicants also submit that restriction pursuant to MPEP 806.05(c) is proper if there is a serious search burden according to MPEP 802.02. However, the Office has failed to provide any explanation as to how a serious search burden exists if restriction is not required. Applicants respectfully submit that no serious search burden exists based upon the multiple prior searches and examinations of claims now subject to the restriction requirement and restriction is improper under MPEP 806.05(c) and 802.02 for at least this compelling reason.

Finally, Applicants note that claims 31-45 identified as being part of Group II depend from claims of Group I. Applicants respectfully submit that the Office has identified claims of Group II (identified as being a subcombination) as depending from claims of Group I (identified as being a combination). Applicants respectfully submit that this grouping of claims illustrates the improper nature of the present rejection inasmuch as the claims 31-45 which depend from claims of the combination are also directed to the combination. Accordingly, Applicants

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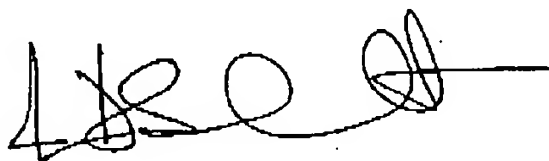
respectfully submit that claims 31-45 directed to the combination should not be restricted since Applicants have elected the group of claims directed to the combination if the restriction requirement is not withdrawn.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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By



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